

03-30-05



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Mark Harris

Examiner : Q. Nguyen

Application No. : 10/018,378

Group Art : 2642

Filing Date : December 18, 2001

Docket No. : 26769.6

Confirmation No. : 7906

Title : NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8*

I hereby certify that the below-identified papers are being deposited with the United States Postal Service with sufficient postage as "FIRST CLASS MAIL" on March 28, 2005 in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents , P.O. Box 1450, Alexandria, Virginia 22313-1450

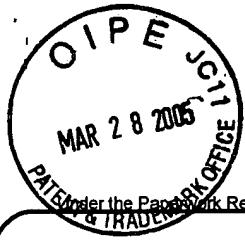
W S HARRERS
(type or print name of person mailing paper)



Signature of person mailing paper

Items enclosed herewith:

1. Appeal Brief
2. Fee Transmittal
3. Credit Card Payment Form
4. Return Receipt Postcard



63-30-05

77W AF
2642

PTO/SB/21 (08-03)

Approved for use through 08/30/2003. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/018,378	
	Filing Date	December 18, 2001	
	First Named Inventor	Mark Harris	
	Art Unit	2642	
	Examiner Name	Q. Nguyen	
Total Number of Pages in This Submission	34	Attorney Docket Number	26769.6

ENCLOSURES (Check all that apply)			
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please Identify below):	
Remarks			
<input type="checkbox"/> _____			

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	W. Scott Harders, Reg. No. 42,629
Signature	
Date	February 9, 2004 28 MARCH 2005

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	W. Scott Harders	
Signature		Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 250.00)

Complete if Known

Application Number	10/018,378
Filing Date	December 18, 2001
First Named Inventor	Mark Harris
Examiner Name	Q. Nguyen
Art Unit	2642
Attorney Docket No.	26769.6

METHOD OF PAYMENT (check all that apply)

 Check Credit card Money Order Other None

 Deposit Account:

 Deposit Account Number
 Deposit Account Name

02-2051

Benesch, Friedlander, C..

The Director is authorized to: (check all that apply)

 Charge fee(s) indicated below Credit any overpayments
 Charge any additional fee(s) or any underpayment of fee(s)
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1) (\$)			

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2) (\$)		

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	250.00
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify) _____			

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 250.00)

(Complete if applicable)

SUBMITTED BY			
Name (Print/Type)	W. Scott Harders	Registration No. (Attorney/Agent)	42,629
Signature		Date	28 MAR 2005

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : HARRIS, Mark Examiner : NGUYEN, Q.
Application No. : 10/018,378 Group Art : 2642
Filing Date : December 18, 2001 Docket No. : 26769-6
Confirmation No. : 7906
Title : NETWORK ADDRESSING SYSTEM
AND METHOD USING SAME

Mail Stop Appeal Brief - Patents
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir/Madam:

The following Appeal Brief is submitted pursuant to the Notice of Appeal filed January 26, 2005 in the above-identified application. This Appeal Brief, filed within two months of the filing date of the Notice of Appeal with a proper certificate of mailing, is therefore timely filed. This is an appeal from the decision of the Examiner mailed July 27, 2004, finally rejecting claims 1-14. The fees required under 37 CFR § 1.17, are detailed and properly paid as stated in the accompanying Fee Transmittal Form. This Appeal Brief is filed in triplicate (37 CFR § 1.192(a)).

03/31/2005 HAL111 00000016 10018378

250.00 OP

01 FC:2402

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST.....	4
II.	RELATED APPEALS AND INTERFERENCES.....	4
III.	STATUS OF CLAIMS.....	4
IV.	STATUS OF AMENDMENTS.....	4
V.	SUMMARY OF CLAIMED SUBJECT MATTER.....	4
VI.	GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	4
VII.	ARGUMENT.....	5
VIII.	CONCLUSION.....	7
IX.	CLAIMS APPENDIX.....	9

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

TABLE OF AUTHORITIES

Cases

<i>In re Fulton</i>	6
<i>In re Beattie</i>	6
<i>Winner Int'l Royalty Corp. v. Wang</i>	6
<i>Ex parte Levengood</i>	6

Statutes

35 U.S.C. § 103.....	4, 5, 6, 7
----------------------	------------

Other Authorities

MPEP § 2143.....	5
MPEP § 2143.01.....	6

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

I. REAL PARTY IN INTEREST

Mark J. Harris, the party named in the caption of this Appeal Brief is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

All Claims, 1-14, have been finally rejected under 35 U.S.C. § 103. Claims 1-14 remain pending and are on appeal (see Section IX, Claims Appendix).

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final Office Action, mailed July 27, 2004 (Exhibit A, hereafter “Final Office Action”).

V. SUMMARY OF CLAIMED SUBJECT MATTER

In a particular embodiment, the application relates to employing telephone numbers, ordered in a typical way, as a domain name to identify a desired device.

The claimed subject matter includes receiving a telephone number portion identifying a device, such as a telephone or network connected device, and converting the telephone number portion into a multiple level domain name identifying the device over a network. Among others, the multiple level domain name includes a plurality of domains corresponding to the telephone number portion and a base portion. The plurality of domains corresponding to the telephone number portion are arranged in an order or sequence corresponding to the telephone number portion.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 -14 have been rejected under 35 U.S.C. § 103 as being obvious in light of the single reference, U.S. Patent No, 5,974,453 to Anderson et al. (Exhibit B, hereafter “Anderson

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

‘453’). The Office concedes that the only reference, Anderson ‘453, does not suggest that the plurality of domains are arranged in an order corresponding to the telephone number. Improperly, the Office never identifies the reference that does suggest the missing element.

VII. ARGUMENT

Claims 1 – 14 are not obvious in light of Anderson ‘453 under 35 U.S.C. § 103.

A. Brief Discussion of Reference

Anderson ‘453 describes a method and system for translating a static identifier, such as a telephone number, into a dynamically assigned network address (Anderson ‘453, Abstract). Anderson ‘453 reverses components of the static telephone number so that more geographically general identifiers are located “to the right” of the network address. In other words, while telephone numbers are arranged with the most general geographic identifier to the “left” (e.g. country code, area code, exchange, number) due to the numbering plan employed by the public switched telephone network, Anderson ‘453 reverses this convention becoming more geographic general toward the “right” of the domain name (Anderson ‘453, column 6, line 63 – column 7, line 4) to mirror the convention of the Domain Name System. As a result, the domain name produced by Anderson ‘453 may incorporate elements of a phone number, but the elements are scrambled (compare, Anderson ‘453 Figure 4, block 400 (phone number) and block 405 (domain name)).

B. Argument

1. The reference of record fails to disclose all the claim limitations

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2143.

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

In the Final Office Action, the Office explicitly admits that Anderson '453 does "not suggest the plurality of domains corresponding to the telephone number portion are arranged in an order corresponding to the telephone number portion" (Exhibit A, Final Office Action, page 2). The Office to date has not offered a reference that does teach or identify a suggestion to make the modification. This alone is sufficient to merit reversal of all the rejections under review because the Office has not yet made out a *prima facie* case of obviousness.

As such, Applicant respectfully submits that the rejection under 35 U.S.C. § 103 is improper and the claims are not rendered obvious by Anderson '453.

2. There is no suggestion to make the proposed modification

A proper obviousness rejection requires the Office to identify a basis in the prior art for the proposed modification. The teaching or suggestion must be found in the prior art, not in applicant's disclosure. MPEP § 2143.01. Recently the Federal Circuit summarized the law in this area in *In re Fulton*. There the court noted that, "the prior art as a whole must 'suggest the desirability' of the combination.' *In re Beattie*, 974 F.2d 1309, 1311 (Fed. Cir. 1992); *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000) ('Trade-offs often concern what is *feasible*, not what is, on balance, *desirable*. Motivation to combine requires the latter.'). The source of the teaching, suggestion, or motivation may be 'the nature of the problem,' 'the teachings of the pertinent references,' or 'the ordinary knowledge of those skilled in the art.' *In re Rouffet*, 149 F.3d at 1355." *In re Fulton*, 2004 U.S. App. LEXIS 24815 (Fed. Cir., December 2, 2004).

In the present application, claim 1 calls for the plurality of domains to be "arranged in an order corresponding to the telephone number portion." The Office correctly notes this element is missing in Anderson '453 (Exhibit A, Final Office Action, page 2). However, the Office incorrectly asserts that it would be obvious to place the reversed sequence of Anderson '453 in an order corresponding to a telephone number to arrive at the present claims. This rejection is improper for at least two reasons.

First, the Office has failed to supply a basis for making the modification. Obviousness requires "some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 1993). In the Final Office Action the

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

Office merely concludes without any analysis or support that the proposed modification is obvious (Exhibit A, Final Office Action, page 3). Because no basis for the modification is provided, the rejection is improper.

Second, Anderson '453 fails to suggest the desirability of the modification. The *Fulton* court's requirement that motivation to combine requires that the proposed changes be desirable, as opposed to merely feasible, clarifies the shortcoming of the Office's position. Anderson '453 lists among the problems it sought to overcome the "inability to scale" (Exhibit B, Column 1, line 49, 50). With this problem in mind, Anderson '453 notes in the Detailed Description that "[o]ne great advantage of this [described] system is that scaling is possible by further dividing the dir-con domain into further subdomains. For example, a hybrid DNS server may serve each area code...." (Exhibit B, Column 5, line 33-36). In other words, Anderson '453 describes a system that scales by assigning sub-domains in order of general increasing geographic specificity – from top level domain, to country, to area code, to number. Anderson '453 does not even mention in passing the possibility – let alone the desirability – that the phone number could be maintained in an order corresponding to the telephone number.

As such, Applicant respectfully submits that the rejection of claim 1 and claims 2 – 6 depending therefrom under 35 U.S.C. § 103 is improper, and the claims are not rendered obvious by Anderson '453.

Claim 7 calls for receiving a static, multiple level domain name arranged in an order corresponding to that of the telephone number portion. The Office has considered claim 7 in connection with claim 1, and thus concedes that Anderson '453 fails to teach or fairly suggest this limitation (Exhibit A, Final Office Action, page 2). Thus, for the reasons above, the rejection of claim 7 and claims 8 and 9 depending therefrom under 35 U.S.C. § 103 is improper and the claims are not rendered obvious by Anderson '453.

Claim 10 calls for an apparatus that receives a telephone number portion identifying a second device, and that converts the received telephone number portion into a static multiple level domain name identifying the second device on the network while preserving sequencing of the telephone number portion. The Office considered claim 10 with claim 1 despite the different claim language, and thus must be held to the admission that Anderson '453 does not teach the

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

claim as presented. Nothing in Anderson '453 suggests that the sequencing of the telephone number be preserved, and in fact discusses in every embodiment that the number is reversed. Thus, for the reasons above, the rejection of claim 10 and claims 11 – 14 depending therefrom under 35 U.S.C. § 103 is improper, and the claims are not rendered obvious by Anderson '453.

VIII. CONCLUSION

Appellant submits that the pending claims are allowable and urges allowance of the claims at an early date.

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment to Deposit Account No. 02-2051, referencing Attorney Docket No. 26769-6.

Dated: 28 MARCH 2005

By:

Respectfully submitted,



W. Scott Harders

Registration No. 42,629

**BENESCH, FRIEDLANDER,
COPLAN & ARONOFF, LLP**
2300 BP Tower
200 Public Square
Cleveland, OH 44114
Direct Dial: (216) 363-4443

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

IX. CLAIMS APPENDIX

IN THE CLAIMS:

1. (Previously Presented) A method comprising:
receiving a telephone number portion identifying a device;
converting the telephone number portion into a multiple level domain name identifying the device over a network, the multiple level domain name comprising a plurality of domains corresponding to the telephone number portion and a base portion, where the plurality of domains corresponding to the telephone number portion are arranged in an order corresponding to the telephone number portion; and
establishing communication with the device via the multiple level domain name over the network.

2. (Original) The method as set forth in claim 1, where the telephone number portion of the multiple level domain name is subordinated to the base portion.

3. (Original) The method as set forth in claim 2, where the base portion of the multiple level domain name comprises a base level domain.

4. (Original) The method as set forth in claim 1, where the converting step comprises:
adding domain separators to the received telephone number portion at determinable locations in the received telephone number portion.

5. (Original) The method as set forth in claim 1, where the received telephone number portion comprises a separator, the converting step comprising:

parsing the received telephone number portion for the separator; and
inserting a domain separator for the parsed separator.

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

6. (Original) The method as set forth in claim 1, further comprising:

appending additional domain levels to the converted telephone number portion to complete the multiple level domain name.

7. (Previously Presented) A method of communicating over a network comprising:

receiving from a first device a static, multiple level domain name at least partially derived from a telephone number portion identifying a second device the multiple level domain name being arranged in an order corresponding to that of the telephone number portion;

determining availability of the second device on the network; and

in response to the determining step, selectively establishing communications from the first device to the second device.

8. (Original) The method as set forth in claim 7, further comprising:

establishing communications from the second device to the first device.

9. (Original) The method as set forth in claim 7, where the determining availability step comprises:

querying the second device over the network; and

receiving a response from the second device indicative of second device availability.

10. (Previously Presented) An apparatus to establish communication between at least two devices over a network, the apparatus comprising a processor which receives from a first device a telephone number portion identifying a second device, and which converts the received telephone number portion into a static multiple level domain name identifying the second device on the network while preserving sequencing of the telephone number portion.

APPEAL BRIEF

Serial No.: 10/018,378

Title: NETWORK ADDRESSING SYSTEM AND METHOD USING SAME

11. (Original) The apparatus as set forth in claim 10, where the processor further establishes communication with the second device over the network.

12. (Original) The apparatus as set forth in claim 10, further comprising a table which matches the static multiple level domain name to an IP address.

13. (Original) The apparatus as set forth in claim 10, where the processor further adds domain separators to the received telephone number portion at determinable locations to result in the static multiple level domain name.

14. (Original) The apparatus as set forth in claim 10, where the received telephone number portion comprises a separator, and where the processor parses the received telephone number portion for the separator and inserts a domain separator for selected instances of the parsed separator.



UNITED STATES PATENT AND TRADEMARK OFFICE

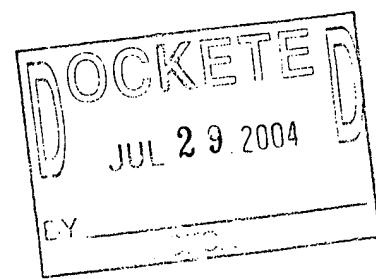
MAR 28 2005

PATENT AND TRADEMARK OFFICE
U.S. DEPARTMENT OF COMMERCE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	RECEIVING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,378	12/18/2001	Mark J. Harris	26769-4	7906
21130	7590	07/27/2004	EXAMINER	
BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP ATTN: IP DEPARTMENT DOCKET CLERK 2300 BP TOWER 200 PUBLIC SQUARE CLEVELAND, OH 44114			NGUYEN, QUYNH H	
ART UNIT		PAPER NUMBER		6
2642				
DATE MAILED: 07/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary



Application No.	Applicant(s)	
10/018,378	HARRIS, MARK J.	
Examiner	Art Unit	
Quynh H Nguyen	2642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Amendment filed 5/17/04.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersen et al. (U.S. Patent 5,974,453).

Regarding claims 1, 10, and 11, Andersen et al. teach receiving a telephone number portion identifying a device (phone number 011-123-456-7890 identifying device 115); converting (“rearranging”) the telephone number portion into a multiple level domain name identifying the device over a network, the multiple level domain name comprising a plurality of domains corresponding to the telephone number portion and a base portion (col. 3, lines 29-41, for example, 7890.456.123.011.dir-con.com); and establishing communication with the device via the multiple level domain name over the network (col. 3, lines 37-48).

However, Andersen et al. do not suggest the plurality of domains corresponding to the telephone number portion are arranged “in an order” corresponding to the telephone number portion.

On one hand, “an order” corresponding to the telephone number would read on the reverse “order” taught by Andersen. A “reverse order” is still an “order”. On the

other hand, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the domains corresponding to the telephone number portion ^{be} may be arranged in "an order" corresponding directly and exactly to the telephone number portion, or in a reverse order. Obviously, either "order" may be chosen without departing from the teachings of Andersen.

Regarding claim 2, Andersen et al. teach the telephone number portion of the multiple level domain names is subordinated to the base portion, for example, 7890.456.123.011.dir-con.com.

Regarding claim 3, Andersen et al. teach the base portion of the multiple level domain names comprise a base level domain, for example, .com.

Regarding claims 4 and 13, Andersen et al. teach adding domain separators to the received telephone number portion at determinable locations in the received telephone number portion ("adding the periods" - col.5, lines 63-67).

Regarding claims 5 and 14, Andersen et al. teach parsing the received telephone number (Fig. 5, 500) portion for the separator ("arrange static identifier to form DNS device name"); and inserting a domain separator for the parsed separator (Fig. 5, 515).

Regarding claim 6, Andersen et al. teach appending additional domain levels to the converted telephone number portion to complete the multiple level domain name (col. 8, lines 12-15).

Claims 7 and 8 are rejected for the same reasons discussed above with respect to claim 1. Furthermore, Andersen et al. teach determining availability of the second device the m on the network (col. 8, lines 19-31); and in response to the determining

step, selectively establishing communications from the first device to the second device (col. 8, lines 44-51).

Regarding claim 9, Andersen et al. teach querying the second device over the network; and receiving a response from the second device indicative of second device availability ("the device 115 is transmitting keep-alive signals") (col. 7, lines 47-64).

Regarding claim 12, Andersen et al. teach matching the static multiple level domain names to an IP address (col. 3, lines 29-40).

Response to Arguments

3. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments are addressed in the above claims rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 703-305-5451. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

qhn

Quynh H. Nguyen
July 22, 2004


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600